



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,687	06/07/2001	Arthur C. Powers	3415-10	8202
7590	12/29/2005			
Myron Cohen, Esq. Cohen, Pontani, Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176			EXAMINER KIM, NICHOLAS J	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,687	Applicant(s) POWERS, ARTHUR C.	
	Examiner Nicholas Kim	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3TH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(see Continuation)</u> . | 6) <input type="checkbox"/> Other: _____ |

IDSs Paper No(s)/Mail Date: 07 June 2001, 11 February 2002, 12 June 2003, and 17 July 2003

DETAILED ACTION

Information Disclosure Statement

1. The Supplemental Information Disclosure Statements (IDSs) submitted on 11 February 2002, 12 June 2003, and 17 July 2003, were filed after the mailing date of the utility application on 7 June 2001. The submissions are in compliance with the provisions of 37 CFR 1.97.

Accordingly, the IDSs are being considered by the examiner.

Oath/Declaration

2. The declaration is defective. A new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

3. The declaration is defective because it incorrectly lists Provisional Application Ser. No. 60/209,923 under a claim to foreign priority. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Drawings

4. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings on file are clearly informal and unclear. For example, hand-written FIGs. 1 and 2 are sufficiently illegible as to be unclear, as are the hand-written feature numbers and corresponding arrows in FIGs. 4-14 and 20-23. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark

Art Unit: 3622

Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: “BAMS” as recited in the claims is misspelled as “BAM!S” throughout Applicant’s specification. Appropriate correction is required if these are typographical errors.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 7-8, 17-21, 25, and 28-29** are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In particular, Claim 7 recites the limitation “optionally” at line 7. Claim 17 also recites “optionally” at lines 21, and 29. Claim 28 also recites “optionally” at line 5. It is unclear whether the limitations following the recitation of “optionally” are required by these claims. Accordingly, for the purpose of expediting examination, the limitations following Applicant’s recitation of “optionally” are interpreted as non-limiting.

9. Claim 17 recites “the data” at line 31. It is unclear to which previous recitation of “data” this term refers.

Art Unit: 3622

10. Additionally, Claim 25 recites the limitation "the database records" at line 4. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1-4, 6-8, 10-11, 14-15, 22-25, 27-29, 31-32, and 35-36** are rejected under 35 U.S.C. 102(e) as anticipated by Horstmann (U.S. Patent No. 6,285,985).

13. Beginning with Claims 1 and 22, Horstmann teaches Applicant's claimed method and system, including establishing and maintaining by the business entity a venture server (FIG. 1 at 109) for providing the at least one BAMS (branding, advertising, marketing, and service) data to the plural electronic devices and for controlling usage and display of the at least one BAMS data at the plural electronic devices (FIG. 1 at 101, "user machine"), preparing by the business entity (Col. 2, l. 62-67, "software developer" teaches Applicant's business entity) a client application (FIG. 1 at 103, "ad module") capable of being run on the processors of the plural electronic

Art Unit: 3622

devices, the client application being configured for performing a function that requires a graphical user interface (GUI) to be displayed in the display (Col. 3, ℓ. 1), for receiving the at least one BAMS data (Col. 3, ℓ. 1), for storing the at least one BAMS data in the memory (Col. 3, ℓ. 57-59, “cache”), and for displaying the at least one BAMS data in the GUI (FIG. 6), distributing the client application to each of the plurality of consumer-users (Col. 2, ℓ. 60-61) assigning a unique identifier to the client application of each of the plurality of consumer-users (Col. 3, ℓ. 62 – Col. 4, ℓ. 26, “user identities and profiles”), installing the distributed client application in the electronic devices of the plurality of consumer-users (Col. 2, ℓ. 60), establishing a communication link between the at least one venture server and the client application installed in the electronic devices of the plurality of consumer-users (FIG. 1), and distributing via the established communication link the at least one BAMS data to the installed client application in the electronic devices of the plurality of consumer-users (Col. 3, ℓ. 1-5).

14. With regard to Claims 2 and 23, Horstmann also discloses that each of the plural electronic devices includes one of a Personal Digital Assistant (PDA), a cellular telephone, a personal computer (PC), and a laptop computer (FIG. 1, user machine 101).

15. Turning to Claims 3 and 24, Horstmann further teaches storing records including the unique identifier and demographic data of a consumer-user of the installed client application to which the at least one unique identifier was assigned (Col. 4, ℓ. 18-26, “remembers user identities and profiles”).

16. Concerning Claims 4 and 25, Horstmann describes that the step of distributing the at least one BAMS data further includes selecting at least one of a consumer-user and a group of consumer-users of the plurality of consumer-users for receiving the at least one BAMS data via

Art Unit: 3622

the established communication link based on the demographic data in the stored records (Col. 3, ℓ. 62-65, “ads targeted to the user based on the user profile”).

17. Addressing now Claims 6 and 27, Horstmann discloses that the stored records further include data concerning at least one of a product and a service of the business entity, the at least one of a product and a service being utilized by the user (Col. 4, ℓ. 1, “user’s usage of the software program”, where the software developer’s product/service is the ad module attached to the program).

18. Moreover, Horstmann anticipates Applicant’s Claims 7 and 28, including tracking electronic device behavior of individual one of the plural consumer-users using the unique identifier assigned to the installed client application on the electronic devices of the individual users of the plural consumer-users (Col. 4, ℓ. 1, “user’s usage of the software program”), and storing the tracked electronic device behavior of the individual ones of the plural consumer-users in the stored records (Col. 3, ℓ. 62-63, Col. 4, ℓ. 20), wherein the distribution of the at least one BAMS data is optionally based on the tracked electronic device behavior (Col. 4, ℓ. 22-25, “avoid or manage repetition” and “remembers what ads were click [sic] on”).

19. With respect to Claims 8 and 29, Horstmann describes that the tracked electronic device behavior of an individual one of the plural consumer-users includes at least one of usage of the client application, browsing on the World Wide Web (WWW), purchase of articles, application usage of the electronic device, and frequency of usage of the electronic device (Col. 4, ℓ. 1-17, “usage of the software program” and “local Web browser”).

Art Unit: 3622

20. Moving to Claims 10 and 31, Horstmann provides that the distributed client application is configured to prevent tracking by the client application of electronic device behavior of a consumer-user (Col. 3, ℓ. 65 – Col. 4, ℓ. 1, “very simple static information”).

21. Horstmann further teaches that the step of distributing the client application is performed by an affiliate of the business entity (Col. 3, ℓ. 6-40, “software vendor”), thereby anticipating Applicant’s Claims 11 and 32. In the code injection approach, the client application is simultaneously distributed by the affiliated software vendor of the program executable.

22. Further, Horstmann discloses Applicant’s Claims 14 and 35, including that the client application includes an application related to an activity of the business entity (Col. 2, ℓ. 1-37). Here, the ad module software relates directly to the activities of the software developer/business entity.

23. Finally, Horstmann describes that all limitations of Claims 15 and 36, including that the at least one BAMS data includes a service message from the business entity to at least one of an individual one of the plural consumer-users and a group of the plural consumer-users, the service message including information concerning at least one of a service and a product of the business entity, the at least one of a service and a product being utilized by the at least one of an individual one of the plural consumer-users and a group of the plural consumer-users (FIG. 5, service data notifying user that Internet is required for the ad module related software program to operate).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 5, 12-13, 26, and 33-34** are rejected under 35 U.S.C. 103(a) as unpatentable over Horstmann in view of Christensen et al. (U.S. Patent No. 5,710,886, herein "Christensen").

26. With regard to Claims 5 and 26, Horstmann does not explicitly teach that the demographic data in the stored records includes zip codes of the plural consumer-users. However, Christensen expressly provides this limitation (Christensen at Col. 13, ℓ. 34-40, ZIP+4). Furthermore, it would have been obvious to one skilled in the art at the time of Applicant's invention to modify Horstmann to include zip codes in the demographic data as taught by Christensen to speed processing of the mail and qualify for reduced postal rates. (Christensen at Col. 13, ℓ. 34-40).

27. Turning to Claims 12-13 and 33-34, Horstmann does not explicitly teach that the step of distributing the client application includes mailing to each of the plural consumer-users computer-readable media on which the client application is stored for installation from the computer-readable media to the electronic device of the each consumer-user. However, Christensen expressly provides these limitations (Christensen at Col. 5, ℓ. 41-42). Furthermore, it would have been obvious to one skilled in the art at the time of Applicant's invention to modify Horstmann to distribute the client application through the mail on computer-readable

Art Unit: 3622

media as taught by Christensen to target desirable demographics with direct mail (Christensen at Col. 6, ¶. 17-27). Additionally, Horstmann explicitly teaches that the computer-readable media mailed to the each consumer-user is accompanied by a product of the business entity since the media taught by the combination of Horstmann and Christensen includes the software developer's own product, the ad module.

28. **Claims 9 and 30** are rejected under 35 U.S.C. 103(a) as unpatentable over Horstmann in view of Gropper (U.S. Patent No. 6,883,000).

29. Although Horstmann teaches a unique identifier, Horstmann does not explicitly teach that the unique identifier is hard-coded in the client application. Gropper expressly provides this limitation (Gropper at Col. 27, ¶. 14-16). Furthermore, it would have been obvious to one skilled in the art at the time of Applicant's invention to modify Horstmann to include the hard-coded identifier of Gropper for advantageously assisting with the registration and establishment of a connection with a new user (Gropper at Col. 26, ¶. 40 - Col. 27, ¶. 28).

30. **Claims 16 and 37** are rejected under 35 U.S.C. 103(a) as unpatentable over Horstmann in view of Gardenswartz et al. (U.S. Patent No. 6,055,573, herein "Gardenswartz").

31. Horstmann does not explicitly teach that the at least one BAMS data includes an electronic coupon. However, Gardenswartz expressly provides this limitation (Gardenswartz at Col. 14, ¶. 47). Furthermore, it would have been obvious to one skilled in the art at the time of Applicant's invention to modify Horstmann to include Gardenswartz's electronic coupon to enable the delivery of promotional incentive (Gardenswartz at Abstract).

32. **Claims 17-21 and 38-42** are rejected under 35 U.S.C. 103(a) as unpatentable over Horstmann in view of Christensen.

33. Addressing first Claims 17 and 38, Horstmann teaches establishing and maintaining by the business entity a venture server for providing the at least one BAMS data to the plural electronic devices and for controlling usage and display of the at least one BAMS data at the plural electronic devices (Horstmann at FIG. 1, ad server 109), preparing by the business entity a client application capable of being run on the processors of the plural electronic devices, the client application being configured for performing a function that requires a graphical user interface (GUI) to be displayed in the display, for receiving the at least one BAMS data, for storing the at least one BAMS data in the memory, and for displaying the at least one BAMS data in the GUI (Horstmann at Col. 3, ℓ. 1, 57-59, ad module), storing records each including at least one of a unique identifier, demographic data of particular one of the plural consumer-users of the client application to which the unique identifier was assigned, and consumer data concerning at least one of a product and a service of the business entity, the at least one of a product and a service optionally being utilized by the particular one of the plural consumer-users (Horstmann at Col. 4, ℓ. 18-26, “remembers user identities and profiles”), establishing a communication link between the venture server and the installed client applications in the electronic devices of the plurality of consumer-users (Horstmann at FIG. 1), and distributing by the business entity via the established communication link the at least one BAMS data to the installed client application in the electronic devices of the plurality of consumer-users (Horstmann at FIG. 1), wherein the business entity optionally selects at least one of one of the

Art Unit: 3622

plural consumer-users and a group of the plural consumer-users for receiving the at least one BAMS data based on the data in the stored records (Horstmann at Col. 4, ¶. 1-25). These features were also discussed above in relation to the rejection of Claims 1 and 22.

34. However, Horstmann does not teach either distributing to each of the plural consumer-users computer-readable media on which the client application is stored for installation from the computer-readable media to the electronic device of the each of the plural consumer-users or installing from the distributed computer-readable media the client application in the electronic devices of the plurality of consumer-users. Christensen expressly provides these teachings (Christensen at Col. 5, ¶. 41-42). Furthermore, it would have been obvious to one skilled in the art at the time of Applicant's invention to modify Horstmann to distribute and install the client application using computer-readable media to advantageously target desirable demographics with direct mail (Christensen at Col. 6, ¶. 17-27).

35. Similar to the rejections of Claims 2, 7-8, 23, and 28-29 above, the limitations of Claims 18-20 and 39-41 are all explicitly taught by Horstmann. In particular, Horstmann discloses that each of the electronic devices includes one of a Personal Digital Assistant (PDA), a cellular telephone, a personal computer (PC), and a laptop computer (Horstmann at FIG. 1, user machine 101), tracking electronic device behavior of individual ones of the plural consumer-users using the unique identifier assigned to the installed client application on the electronic devices of the plurality of consumer-users (Horstmann at Col. 4, ¶. 1, "usage"), and storing in the stored records data regarding the tracked electronic device behavior of the individual ones of the plural consumer-users (Horstmann at Col. 3, ¶. 62 – Col. 4, ¶. 20), wherein the tracked electronic device behavior of an individual one of the plural consumer-users includes at least one of usage

Art Unit: 3622

of the client application, browsing on the World Wide Web (WWW), purchase of items, application usage of the electronic device, and frequency of usage of the electronic device by the individual one of the plural consumer-users (Horstmann at Col. 4, ¶. 1-17, “usage of the software program”).

36. Finally, with regard to Claims 21 and 42, although Horstmann teaches distribution of the client application by an affiliate of the business entity (Horstmann at Col. 3, ¶. 6-40, “software vendor”) and the client application including an application related to an activity of the business entity (Horstmann at Col. 2, ¶. 1-37, software developer’s ad module is their activity), Horstmann does not teach that the distributed computer-readable media is accompanied by a product of the business entity. However, Christensen expressly remedies this deficiency as discussed previously with regard to Claims 12-13 and 33-34 (Christensen, at Col. 5, ¶. 41-42 and at Col. 6, ¶. 17-20).

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to Applicants’ disclosure. Peppel (U.S. Patent No. 6,200,216) describes a CD-ROM including electronic trading cards offered as promotional giveaways or bundled with related product purchases. Tycksen, Jr. et al. (U.S. Patent No. 5,898,777) describes digital products distributed by direct mail or give-away packages on CD or diskette. Dwork (U.S. Patent No. 5,978,482) describes a hard-coded unique identifier. Hoyle (U.S. Patent No. 6,141,010) describes a software application that targets ads in response to user interaction with the computer including a “blueprint” identifier for program modules where the application may be downloaded or installed

Art Unit: 3622

from a CD or DVD. Reilly et al. (U.S. Patent No. 5,740,549) describes the PointCast system of providing information and advertisements according to subscriber profile data. Guyot et al. (U.S. Patent No. 6,119,098) describes a method for targeting and distributing advertisements using a client application. Brown (Brown, Ken Spencer, "Irvine Developer Skips Busy Web, puts ads right in Software," Orange County Business Journal, Jun 5-11, 2000, Vol. 23, Iss. 23, p. 4) and Business Wire ("Free Software Creates WWF Theme Personal Interactive PC Desktop; I-xposure Captures the PC Desktop for the World Wrestling Foundation," Business Wire, May 1, 2000, p.1) describe software created by I-xposure, Inc., Personal interactive desktops (PIDs), that combines a suite of personalized management tools for daily tasks and advertisements downloaded from affiliate or sponsor websites or shipped via CD-ROM.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

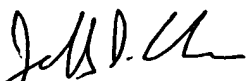
39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3622

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK


JEFFREY D. CARLSON
PRIMARY EXAMINER